

Application No. 09/168,972
Response and Amendment, filed November 21, 2007
In response to Office Action mailed May 21, 2007

REMARKS

The Office Action dated May 21, 2007 (the “Office Action”) rejected all pending claims in this application, which include claims 28-62 and independent claims 28 and 57.

Claims 28, 31-34, 39, 40, 57, and 59-61 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent number 6,135,453 to Srichayaporn (henceforth, “Srichayaporn”). Claims 29, 30, 35-38, 41, 43-56, 58, and 62 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Srichayaporn in view of U.S. Patent number 5,597,162 to Franklin (henceforth, “Franklin”). Additionally, claim 42 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Srichayaporn and Franklin in further view of U.S. Patent No. 5,810,354 to Banyai. (henceforth, “Banyai”).

In the present Response and Amendment, the claims 29 and 62 have been amended for sake of clarity. No prohibited new matter has been introduced into the present application through these amendments. Claims 28-62 still remain pending in this application.

Entry of this amendment and reconsideration of the grounds for rejection in the Office Action in light of the following specific remarks is thus requested.

**I. APPLICANT'S AFFIDAVIT UNDER 37 CFR 1.131 REMOVES
SRICHAYAPORN AS PRIOR ART**

Applicant notes that the Office Action purports to apply Srichayaporn as prior art under 35 U.S.C. § 102(b). This is improper. Srichayaporn was granted and published Oct. 24, 2000 while Applicant’s filing date is Oct. 8, 1998. Thus, Srichayaporn could only serve as

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presumptive prior art under 35 U.S.C. § 102(e) based upon Srichayaporn's filing date of Aug. 25, 1998.

However, Applicant has submitted herewith an Affidavit under 37 C.F.R. § 1.131 signed by the inventor Nicholas Marchesani. This declaration provides invention records predating the filing date of Srichayaporn, and those records provide details regarding conception of each element of the claims prior to the filing date of Srichayaporn (at least as early as May 1998), followed by diligent reduction to practice of the invention (at least as early as Aug. 3, 1998, and no later than Sept. 17, 1998). The Affidavit provides dated correspondence to and from the inventor and inventor's patent attorney in this time frame, which correspondence clearly establishes dates of invention that remove Srichayaporn as presumptive prior art under section 102(e).

The attached Exhibits A, B, and D provide clear record of the conception and reduction to practice of each element of the claims. With respect to claims 28 and 57, the step of "providing a standard deck of cards" can be found in Exhibit A at page 2, and also in Exhibit D at page 3, lines 16-17. The step of "having a dealer deal a set of cards to each of a plurality of players and to the dealer itself, an equal number of cards being dealt to each player, said equal number being from 3 to 7" can be found in Exhibit A at page 2, in Exhibit B at page 1 (explaining that the number of cards dealt can be 3, 4, 5, 6, or 7), and also in Exhibit D at page 3, lines 18-21. The step of "having each player make a single wager prior to viewing the face value of their respective cards" can be found in Exhibit A at page 2, and also in Exhibit D at page 3, lines 22-24. The step of "having each player split their respective set of cards into two half-hands, by forming a first half-hand having a LOW value card combination and a second half-hand having a

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HIGH value card combination wherein the total number of cards in either half-hand does not exceed the total number of cards in the other half-hand by more than one card” can be found in Exhibit A at pages 2-3, and also in Exhibit D at page 3, line 24 to page 4, line 3. The step of “having the dealer split its set of cards into two half-hands, a first half-hand having a LOW value and a second half-hand having a HIGH value wherein the total number of cards in either half-hand does not exceed the total number of cards in the other half-hand by more than one card” can be found in Exhibit A at pages 2-3, and also in Exhibit D at page 4, lines 3-6. The step of “designating a player as a winner if both (a) that player’s LOW hand is lower than the dealer’s LOW hand and (b) that player’s HIGH hand is higher than the dealer’s HIGH hand” can be found in Exhibit A at page 3, and also in Exhibit D at page 4, lines 6-9.

With respect to claim 29, the limitation “wherein each of said players and said dealer are dealt 4 cards, wherein each of said players may opt to discard one of said 4 dealt cards to them and draw a replacement card upon the payment of a fee, and wherein said dealer can discard a card and draw a replacement card only if said 4 dealt cards dealt to said dealer meet a predetermined criteria” can be found in Exhibit A at page 2, and also in Exhibit D at page 11, line 20 to page 12, line 4, and at page 12, lines 12-19.

With respect to claim 30, the limitation “wherein said predetermined criteria comprises when at least 3 of said 4 dealt cards dealt to said dealer are equal in value and when at least 3 of said 4 dealt cards dealt to said dealer are one of a 6, 7, 8, or 9” can be found in Exhibit A at page 2, and also in Exhibit D at page 12, lines 12-19.

With respect to claim 31, the limitation “wherein said step of having a dealer deal includes dealing 4 cards to each player and wherein said steps of splitting the player’s and

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dealer's cards into half-hands includes making each half-hand with 2 cards" can be found in Exhibit A at page 2, and also in Exhibit D at page 9, lines 1-6.

With respect to claims 32 and 59, the limitation "wherein said step of designating a player as a winner . . . is based on valuing aces as either 1 or 11, valuing 2's through 10's as 2 through 10, respectively, and valuing jacks, queens and kings as 10" can be found in Exhibit A at page 2, and also in Exhibit D at page 9, lines 9-13.

With respect to claims 33 and 60, the limitation "wherein said step of designating a player as a winner . . . is based on poker values of the cards" can be found in Exhibit B at page 1, and also in Exhibit D at page 9, lines 19-21.

With respect to claims 34 and 61, the limitation "wherein said step of designating a player as a winner . . . is based on valuing aces as 1, valuing 2's through 10's as 2 through 10, respectively, and valuing jacks as 11, queens as 12 and kings as 13" can be found in Exhibit A at page 2, and also in Exhibit D at page 9, lines 15-19.

With respect to claims 35 and 62, the limitation "wherein, after placing said wagers and prior to splitting the dealt card into half-hands, a single replacement card can be purchased by any player upon the payment of a predetermined replacement fee and discarding one of said dealt cards, and wherein, prior to splitting the dealer's dealt cards into half-hands, said dealer can draw a single replacement card under predefined conditions" can be found in Exhibit A at page 2, and also in Exhibit D at page 11, line 20 to page 12, line 4, and at page 12, lines 12-19.

With respect to claim 36, the limitation "wherein said replacement fee is 50% of the initial wager" can be found in Exhibit A at page 2, and also in Exhibit D at page 11, line 24 to page 12, line 1.

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With respect to claim 37, the step of "giving that player winnings in the amount of a 1 to 1 pay-out minus a commission fee" can be found in Exhibit A at page 3, and also in Exhibit D at page 15, lines 13-18.

With respect to claim 38, the step of "designating a player's hand as a push when either (a) one of the player's half-hands wins and the other of the player's half-hands loses; or (b) one of the player's half-hands wins and the other half-hand ties a non-losing half-hand of said dealer" can be found in Exhibit A at page 4, and also in Exhibit D at page 16, lines 4-7.

With respect to claim 39, the step of "designating a player's hand as a loser when either (a) both of the player's half-hands lose to respective half-hands of said dealer; or (b) one of the player's half-hands loses to a first corresponding half-hand of said dealer and the player's other half-hand ties a second corresponding half-hand of said dealer" can be found in Exhibit A at page 4, and also in Exhibit D at page 15, line 23 to page 16, line 3.

With respect to claims 40, 41, 43, 44, and 45, the limitations wherein the players and dealer are dealt three, four, five, six, or seven cards can be found in Exhibit B at page 1, and also in Exhibit D at page 3, lines 20-21.

With respect to claim 42, the step of "giving the player an award if the player is dealt a hand of four-of-a-kind" can be found in Exhibit A at page 5, and also in Exhibit D at page 16, lines 11-12.

With respect to claim 46, the step of "allowing a player to bank a hand for a fee provided the banking player has enough money to pay 100% of all potentially winning wagers to all remaining non-banking players" can be found in Exhibit A at page 3, and also in Exhibit D at page 14, lines 8-13.

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With respect to claim 47, the step of “allowing a player to co-bank a hand with the dealer for a fee provided the banking player has enough money to pay 50% of all potentially winning wagers to all remaining non-banking players” can be found in Exhibit A at page 3, and also in Exhibit D at page 14, line 24 to page 15, lines 5.

With respect to claim 48, the step of “each player and said dealer discarding a predetermined number of the dealt cards” can be found in Exhibit A at page 2 (explaining that each player can be dealt five cards, and then throw one back), and also in Exhibit D at page 12, line 24 to page 13, line 3.

With respect to claim 49, the limitation “wherein said predetermined number of the cards to be discarded is one card” can be found in Exhibit A at page 2, and also in Exhibit D at page 13, lines 1-3.

With respect to claims 50 and 58, the limitation, “wherein the said predetermined number of the cards is the amount of cards necessary to leave each said player and said dealer with 4 cards” can be found in Exhibit A at page 2, and also in Exhibit D at page 13, lines 1-4.

With respect to claims 51-56, each claim recites some variation of the limitation wherein either the players or the dealer, or both, are dealt more than four cards and then discard the number of cards necessary to leave them with four. Thus, the limitations in claims 51-56 can generally be found in Exhibit A at page 2 (explaining that each player can be dealt five cards, and then throw one back so that they have four cards), and also in Exhibit D at page 12, line 24 to page 13, line 4.

The present claims clearly have a date of invention prior to the filing date of Srichayaporn, making that reference unavailable as prior art under section 102(e). Thus, any and

all rejections that rely upon Srichayaporn, whether alone under § 102 or in part under § 103, must be withdrawn. Reconsideration and removal of the prior art rejections relying upon these references is thus respectfully requested.

**II. CLAIMS 28-62 DEFINE PATENTABLE SUBJECT MATTER PURSUANT
TO 35 U.S.C. § 103**

In further response to the Office Action, the Applicant again asserts for the record that a "winning scheme" substantially defines and differentiates any game. Changing a card game's winning strategy defines a new game as opposed to merely redefining an old game. The winning scheme of the present invention has been found to provide a fast passed game allowing players of all levels to easily participate, the excitement level to remain high, while still allowing quick processing of the game and wagers by the casino to maintain profitability of the game in a casino setting. These factors work together to keep the tables filled with players, and provide the casinos with a steady source of income from players who find other gambling card games too risky. Thus, both players and casino operators benefit from the winning scheme of the present invention in ways not provided for in the prior art cited in the Office Action. Accordingly, Applicant asserts that these aspects are not available in the prior art and further support that the present invention is new and unobvious.

In the presently claimed invention, "half-hands" are specifically limited in the number of cards they can contain such that the total number of cards in either half-hand does not exceed the total number of cards in the other half-hand by more than one. In other words, the difference in the number of cards in each half-hand is no greater than one. Thus, the current invention does

not involve 5:2, 4:2, or 3:1 splitting of hands of cards. Thus, based on the above discussion, there are significant differences in game play between the seven-card versions of the current invention and the games taught by the prior art.¹

While Breeding and Shen are not applied in the present Office Action, the Applicant takes this opportunity to revisit how the present claims distinguish over those references. In reference to Breeding, the January 10, 2001 Office Action stated, "the determination is that choosing a different winning scheme does not change the game. It only changes the strategy and odds in a known and expected way that is within the skill of one practicing the art." The November 15, 2000 Office Action asserts that Applicant's invention is "conventional Asian or Pai Gow poker as shown in Breeding.... The only difference is how the players are declared the winner." The November 15, 2000 Office Action further attempts to explain that one of ordinary skill in the art would be able to change the winning scheme of Breeding to produce the present invention without being "inventive." The August 15, 2000 Office Action states that a "winning scheme is nothing more than a predetermine[d] criteria that must be met by a player in order to [be] considered a winner . . . [and while] a change in design may make the games different, the games may not be patentably distinct."

Breeding discloses a modification of the traditional game of Pai Gow poker wherein each of the players is dealt seven cards. The seven cards are then divided by each player into two split sets, one having five cards and the other having two cards. For a player to win a wager based on

¹ For example, in two of the seven-card versions of the current invention the player must contemplate and strategize for a three-card half-hand. In prior art Pai Gow poker, seven-card hands are dealt and there never is a three-card half-hand, rather the player must contemplate and strategize for a five-card half-hand (which is equivalent to playing regular five-card poker) and a two-card half-hand. Furthermore, no version of the seven-card versions of the current invention

their cards, each split set must outrank those of the dealer. For a player to lose a wager based on their cards, each split set must be outranked by those of the dealer. A push is gained with one split set outranking the dealer and one split set being outranked by the dealer. Breeding discloses a game based only on poker scoring.

Notably, Applicant's claims differ from Breeding from the claims' recitation and definition of "half-hands." In Breeding, each of the players are dealt seven cards. The seven cards are then divided by each player into two split sets, one having five cards and the other two cards. This is clearly not splitting cards into two "half-hands" as claimed by Applicant, and Breeding does not teach or suggest any variation of this dealing and playing methodology.

Further, as described in detail on the record previously by the Applicant, how the winner is determined according to Breeding's disclosed game is clearly significantly different from the manner recited in Applicant's claims. The combination of the half-hands limitation with the winning scheme limitation of Applicant's claims clearly define a new and non-obvious game.

Shen is directed toward a card game that uses four cards. The four dealt cards are divided into two split sets of two cards (2:2). The object is to create the two highest value two-card half-hands within the scoring rules. In order for a player to win, both of the player's half-hands must be higher than the dealer's two half-hands. A player loses if both half-hands are lower than the dealer's half-hands. Finally, the hand is a push if a player wins one half-hand and loses the other.

Shen utilizes a modified blackjack scoring system and a poker tie breaker system. Cards are valued and added together according to blackjack rules. Once added, however, the "tens" digit is ignored for values above nine; only the ones digit is considered. For example, any two

requires the player to contemplate or strategize for a five-card half-hand.

cards totaling 18 would equal 8. Thus an 18 would lose to both of a half-hand of a 5 and a 4 (totaling 9) as well as a half-hand of a 10 and a 9 (totaling 19). However, a face card (valued at 10) and a 9 (or an ace and 8) trumps a 5 and a 4 even though both equal 9. Additionally, pairs of cards beat any set of added cards; a pair of 2s beats a King and a 9. If the dealer and player have the same half-hand, the dealer wins.

Shen and the currently claimed invention are thus dissimilar in several ways. The current invention can be played with between three and seven cards. Shen et al. only teaches game play with four cards and does not provide any suggestion to modify its game play. Further, and most importantly, the manner in which the winner is determined is completely different.

The object of Shen is to create the two highest value two-card half-hands within the scoring rules. In order for a player to win, both of the player's half-hands must be higher than the dealer's two half-hands. A player loses if both half-hands are lower than the dealer's half-hands. Finally, the hand is a push if a player wins one half-hand and loses the other. As discussed above and recited in claims 28 and 57, according to the present invention, a winner is declared when a player's low hand is lower than the dealer's hand and that player's high hand is also higher than the dealer's high hand.

Thus, it is respectfully submitted that Shen in combination with Breeding fails to disclose or teach the features of claims 28 or 57. Therefore, withdrawal of the rejection of claims 28 and 57 under 35 U.S.C. §102 with regard to Breeding is respectfully requested. Accordingly, any rejection of claims 28-62 under 35 U.S.C. §103 comprising a purported combination of Breeding and Franklin would be improper.

III. CLAIMS 29, 30, 35-38, 41, 43-56, 58, and 62 DEFINE PATENTABLE SUBJECT MATTER PURSUANT TO 35 U.S.C. § 103

With regard to claim 29, the Office Action alleges that Franklin teaches that a player is permitted to draw a replacement card for a fee. This is untrue. Franklin teaches the player being able to draw a second replacement card if they make a second bet. As will be readily appreciated by one skilled in the art, placing a bet (which increases your payback if you win) is very different from a straight payment to receive a replacement card.

Franklin thus fails to remedy the deficiencies of Breeding and, as a result, the combination of Breeding in view of Franklin does not provide the invention of claims 29, 35-26, and 62. Accordingly, a rejection of claims 29, 35-36, and 62 under 35 U.S.C. §103 comprising a purported combination of Breeding and Franklin would be improper.

The Office Action also rejects claim 42 pursuant to 35 U.S.C. §103 as being unpatentable over Srichayaporn, in view of Franklin and Banyai. The potential combination of Breeding, Franklin, and Banyai will now be discussed. Banyai discloses a complex poker game where a bonus is paid to losing players holding predetermined card combinations. In contrast, the present invention provides for an award to a player dealt a four-of-a-kind, whether the hand is a winning hand or a losing hand. Thus, the present invention is neither taught nor suggested by the these references. Accordingly, a rejection of claim 42 under 35 U.S.C. §103 comprising a combination of Breeding, Franklin and Banyai would likewise be improper.

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CONCLUSION

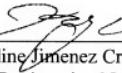
In view of the foregoing, the Applicant respectfully requests that the Examiner reconsider the claims as amended and in light of the above remarks. A timely allowance of all of the pending claims is requested.

The present Response and Amendment has been submitted concurrently with a Transmittal document serving as a formal request for a three-month extension of time and a deposit account authorization for the fee amount due in conjunction with that request. If there are any other fees due in connection with the filing of this Response, or if the appropriate extension fee amount has not been authorized on the Transmittal document, please charge any necessary fees to Deposit Account No. 50-1349.

The Examiner is requested to contact Applicants' undersigned attorneys by telephone to discuss any matters if the Examiner feels such discussions may expedite the progress of the present application toward allowance and avoid the need for further Office Actions.

Respectfully submitted,

Dated: November 21, 2007

By: 

Celine Jimenez Crowson
Registration No. 40,357

HOGAN & HARTSON LLP
555 13th Street, N.W.
Washington, D.C. 20004
Telephone: 202-637-5600
Facsimile: 202-637-5910
Customer No. 24633

Kevin G. Shaw
Registration No. 43,110